

REMARKS

Claims 1-22 were pending in this application.

Claims 1-22 have been rejected.

Claims 1 and 9 have been amended as shown above.

Claims 1-22 remain pending in this application.

Reconsideration and full allowance of Claims 1-22 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,182,238 to Cooper (“*Cooper*”) in view of U.S. Patent No. 4,530,051 to Johnson et al. (“*Johnson*”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability,

then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

First, the Office Action acknowledges that *Cooper* fails to disclose updating a multitask vector associated with a "first subroutine" and transferring "program execution control" from the subroutine back to a "main routine" after encountering a "decision point" in the first subroutine that cannot be decided, where the first subroutine is "callable by [the] main routine" as recited in Claim 1. (*Office Action*, Page 5, Last paragraph – Page 6, First paragraph). The Office Action then asserts that *Johnson* discloses these elements of Claim 1 and that it would be obvious to combine *Cooper* and *Johnson*. (*Office Action*, Page 6, First paragraph).

The Office Action cites column 7, line 10 through column 8, line 28 of *Johnson* as disclosing these elements of Claim 1. However, this portion of *Johnson* contains absolutely no mention of a “first subroutine” that is “callable by [a] main routine” and that “transfers program execution control back to [the] main routine” after encountering a “decision point” in the subroutine that cannot be decided as recited in Claim 1.

Johnson simply recites that a “home process” executing on a “home processor” can invoke a “remote process” or a “subject process” on a “remote processor.” (*Abstract*; *Col. 7, Lines 63-65*). The subject process is executed, and the results are returned to the home process. (*Col. 7, Line 63 – Col. 8, Lines 28*). The subject process may itself invoke execution of other subject processes. (*Col. 7, Lines 25-41*). Various process control mechanisms are described for allowing the processes to be monitored and controlled. (*Abstract*).

This portion of *Johnson* simply recites that the subject process executes and returns its results to the home process. This portion of *Johnson* contains absolutely no mention that the subject process may fail to execute completely and transfer control back to the home process before execution of the subject process is complete. More specifically, this portion of *Johnson* contains absolutely no mention that the subject process may transfer “program execution control” from the subject process back to the home process upon encountering a “decision point” that is “not yet capable of being decided” as recited in Claim 1.

Second, the Office Action once again fails to establish that a person skilled in the art would be motivated to modify *Cooper* with the recitations of *Johnson*. In making the § 103 rejection, the Office Action notes that *Cooper* fails to explicitly teach various elements of Claim

1. (*Office Action, Page 3, First paragraph*). The Office Action then asserts that this failure “necessitates” using the recitations of *Johnson* to modify *Cooper*.

In effect, the Office Action argues that *Cooper* fails to recite all elements of Claim 1, so a person skilled in the art would be motivated to combine *Cooper* with *Johnson*. However, this represents an improper § 103 rejection because the Patent Office is relying on the Applicants’ disclosure to make the rejection. In other words, the Office Action is using Claim 1 as the basis for saying a person skilled in the art would be motivated to combine *Cooper* and *Johnson*.

Moreover, the Office Action is asserting that it would be obvious to combine the process control mechanisms of *Johnson* with the system of *Cooper*. However, the process control mechanisms of *Johnson* are used to control the various home process and subject processes being executed in the system of *Johnson*. Because of this, before arguing that it would be obvious to combine the process control mechanisms of *Johnson* with the system of *Cooper*, the Office Action must first show that it would be obvious to combine the home process/subject process mechanism of *Johnson* with the system of *Cooper*. The Office Action fails to make this showing. The Office Action simply assumes that a person skilled in the art would be motivated to use the home process/subject process mechanism of *Johnson* in *Cooper*. The Office Action then argues that since home and subject processes could be used in *Cooper*, the control mechanisms of *Johnson* should also be used in *Cooper*.

The entire purpose of *Johnson* is to split execution of a program. A home process executes on one processor, and one or more remote processors may execute subject processes

needed by the home process. A person skilled in the art has absolutely no motivation to implement the home process and subject processes on a single processor of *Cooper*.

The Office Action cannot simply assert that there is “no relevancy” as to whether the processes of *Johnson* are “executed on one processor or multiple processors.” (*Office Action, Page 4, First paragraph*). The burden is on the Patent Office to establish that a person skilled in the art would be motivated to modify *Cooper* with *Johnson*. The entire purpose of *Johnson* is to execute a program using multiple processors. The Office Action fails to cite any motivation as to why a person skilled in the art would use the system of *Johnson* on the single processor of *Cooper*.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness against Claim 1 (and its dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1-8. Independent Claims 9 and 17 (and their dependent claims) are patentable for the same reasons given above. Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 9-22.

II. CONCLUSION

As a result of the foregoing, the Applicants assert that the claims in this application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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William A. Munck

Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *wmunck@davismunck.com*